REMARKS

I. STATUS OF CLAIMS

Claims 1-99 are pending. Claims 2-16 and 96-98 are withdrawn from consideration for being drawn to non-elected subject matter. For the record, Applicants maintain their traversal of the restriction requirement as applied to claims 1-99. Claim 1 has been amended to include the recitations in claim 18, which has been canceled. The dependency of claim 19 has been amended due to the cancellation of claim 18. Accordingly, no new matter has been added by the these amendments.

II. REJECTIONS UNDER 35 U.S.C. § 103

A. Hanna et al. (U.S. Patent No. 5,843,417)

Claims 1, 17-42, 49-52, 70-95 and 99 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,843,417 to Hanna et al. ("Hanna"). Office Action at p. 4. Applicants submit that the claimed invention is not obvious in view of Hanna for the reasons of record as well as the additional reasons set forth below.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. M.P.E.P. § 2142. In *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007), the Supreme Court confirmed that the "framework for applying the statutory language of §103" was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious:

(1) the scope and content of the prior art;

(2) the differences between the prior art and the claims at issue;

(3) the level of ordinary skill in the art; and

(4) secondary considerations.

383 U.S. at 17, 148 U.S.P.Q. at 467. Although the question of obviousness must be resolved on the basis of these factual determinations, the Supreme Court pointed out that there is no inconsistency between the *Graham* analysis and the idea underlying the teaching, suggestion, or motivation ("TSM") test. *KSR*, 127 S. Ct. at 1741, 82 U.S.P.Q. 2d at 1389. Further, in its recently published examination guidelines, the USPTO has solidified that the TSM test is a valid rationale for determining obviousness. *See* M.P.E.P. § 2141.

In the present case, independent claim 1 has been amended to include the recitations in claim 18, which has been canceled. Accordingly, amended claim 1 now recites:

> A foundation in the form of a water-in-oil emulsion comprising:
>
> - a fatty phase;
> - an aqueous phase;
> - at least one surfactant chosen from C_8-C_{22} alkyl dimethicone copolyols;
> - at least one other surfactant chosen from dimethicone copolyols, <u>wherein the at least one other surfactant chosen from dimethicone copolyols is present in an amount ranging from 5% to 10% by weight, relative to the total weight of the emulsion</u>; and
> - hydrophobic coated pigments,

> wherein the fatty phase comprises at least 30% by weight, relative to the total weight of the emulsion, of a volatile fatty phase comprising:
>
> - at least 6% by weight, relative to the total weight of the emulsion, of at least one volatile hydrocarbon oil; and
> - at least one volatile oil chosen from volatile silicone oils and volatile fluorinated oils. (Emphasis added).

Although the Examiner rejects claim 18 based on Hanna, Hanna does not disclose or suggest introducing the specific combination of at least one C_8-C_{22} alkyl dimethicone copolyol (*e.g.*, a cetyl dimethicone copolyol) and at least one other dimethicone copolyol as surfactants in a cosmetic composition, wherein the at least one other surfactant chosen from dimethicone copolyols is present in an amount ranging from 5% to 10% by weight, relative to the total weight of the emulsion. At col. 4, lines 56-57, Hanna discloses that their compositions preferably comprise one or more surfactants. At col. 5, lines 3-7, Hanna mentions that the surfactant can be a "dimethicone copolyol, laurylmethicone copolyol, glyceryl stearate, beeswax, cetyl dimethicone copolyol, polyglyceryl-4-isostearate, hexyl laurate, etc." and that "mixtures of . . . surfactants may be used" and at col. 5, lines 29-31, Hanna discloses that the <u>total</u> amount of oil surfactant is from 5 to 15 wt%. However, there is no guidance in Hanna that, in addition to at least one C_8-C_{22} alkyl dimethicone copolyol, another dimethicone copolyol is present in an amount ranging from 5% to 10% by weight. Applicants submit that there are substantial differences between Hanna and the claimed invention, and these differences are so great to render the claimed invention non-obvious to one reasonably skilled in the art. *See* M.P.E.P. § 2141(III) (citation omitted). Accordingly,

Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness in view of the presently amended claims.

Additionally, even if the Examiner has established that the claimed invention is obvious, which he has not, Applicants can rebut a *prima facie* case of obviousness by presenting comparative test data showing that the claimed invention possesses unexpectedly improved properties or properties that the prior art does not have. *See* M.P.E.P. § 716.02(a). "A greater than expected result is an evidentiary factor pertinent to the legal conclusion of obviousness." *In re Corkill*, 711 F. 2d 1496, 226 U.S.P.Q. 1005 (Fed. Cir. 1985).

Applicants have conducted experiments to demonstrate the unexpected superiority of the claimed foundation. In the following experiments, Example 1 corresponds to the foundation of example 1 in the present specification. *See* Applicants' specification at pages 24-25. Example 1 has been compared with compositions A and B, wherein the amount of dimethicone copolyol is outside the claimed range. Specifically, composition A comprises 0.5% by weight of dimethicone copolyol (KF-6017 from Shin Etsu), and composition B comprises 4% by weight of dimethicone copolyol (KF-6017 from Shin Etsu). In the interest of consistency, in each composition, Example 1 and compositions A and B, the balance was comprised of cyclopentasiloxane oil. The values in the table provided below are expressed as % by weight.

	Ex 1 (invention)	Composition A (Comparative)	Composition B (Comparative)
Isododecane	13	13	13
Cyclopentasiloxane	**16**	**20,5**	**17**
Cyclohexasiloxane	8	8	8
Polydimethylsiloxane (DC 200 Fluid - 5 cst from the company DOW CORNING)	2	2	2
Isoeicosane	3	3	3
Cetyl dimethicone copolyol (Abil® Em 90 from the company GOLDSCHMIDT)	0,8	0,8	0,8
Dimethicone copolyol (KF6017 from Shin Etsu)	**5**	**0,5**	**4**
Polyglyceryl isostearate (4 mol of glycerol)	0,6	0,6	0,6
Hectorite	1,4	1,4	1,4
Iron oxides coated with perfluoroalkyl phosphate	2	2	2
Titanium oxide coated with perfluoroalkyl phosphate	5,5	5,5	5,5
Nylon powder	4	4	4
Butylene glycol	10	10	10
Sodium chloride	0,7	0,7	0,7
Preservatives	qs	qs	qs
Water qs	25,3 (qsp 100 %)	25,3 (qsp 100 %)	25,3 (qsp 100 %)

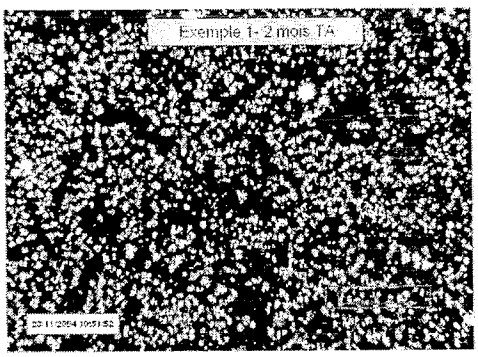
Each emulsion, Example 1 and Compositions A and B, was prepared as discussed in paragraph [089] in the specification. After 24 hours at room temperature (25°C), the viscosity of each composition was measured with a Rheomat 180 viscometer equipped with the mobile n°2, shearing rate of 200 s^{-1}, after 10 minutes of mobile rotation. These measurements are provided in the table below.

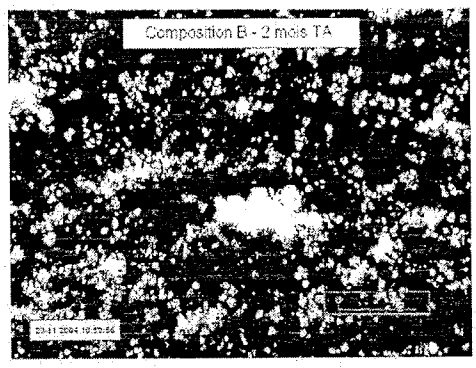
	After 24 hours ($Pa.s^{-1}$)
Example 1	0.35
Composition A	0.13
Composition B	0.22

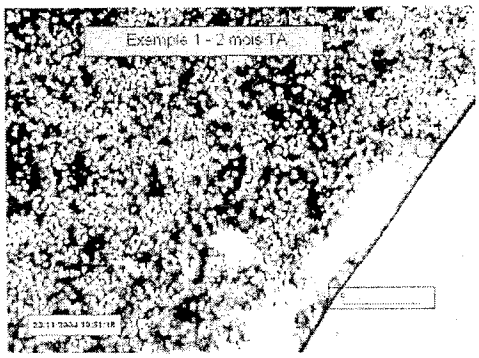
As shown above the viscosity of composition A after just 24 hours was significantly less as compared with the viscosity of Example 1 and composition B, and it was determined that composition A was not stable after 24 hours at room temperature.

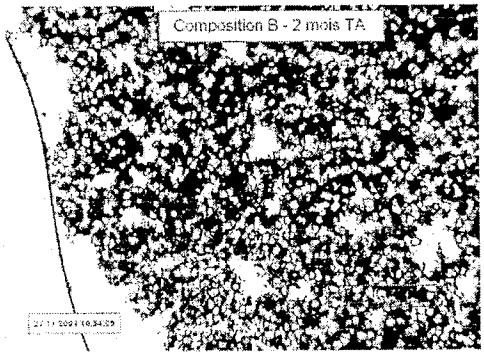
After 2 months at room temperature, Example 1 and composition B were analyzed under a microscope to examine their homogeneity and stability. The following photos were taken of Example 1 and Composition B.

Example 1 **Composition B**









As shown in the photos, the composition of Example 1 is a homogeneous emulsion with very small droplets of water; whereas, the emulsion according to composition B was not homogeneous and has large droplets of water. Thus, these photos show that Example 1 is more homogeneous and stable than composition B. Accordingly, based on the experiments conducted, it is evident that, in accordance with the teachings in the specification at paragraph [006], the claimed foundation has unexpectedly superior homogeneity and stability as compared with compositions A and B.

For at least the foregoing reasons, Applicants submit that the Examiner failed to establish a *prima facie* case of obviousness based on Hanna, particularly in view of the

present amendments. Moreover, even if the Examiner established that the claimed invention is obvious, Applicants presented sufficient evidence to rebut any *prima facie* showing. Accordingly, Applicants submit that the rejection of claims 1, 17-42, 49-52, 70-95 and 99 under § 103 is improper and should be withdrawn.

B. Hanna in view of Elm et al. (U.S. Patent No. 4,552,753)

Claims 43-47 and 53-59 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanna as applied to claims 1, 17-42, 49-52, 70-95 and 99 above, and further in view of US Patent No. 4,552,753 to Elm et al. ("Elm"), and as evidenced by the Aldrich Catalog 2003-2004. Office Action at pp. 6-7. Applicants respectfully disagree and traverse the rejection for the reasons of record and for the additional reasons discussed below.

As discussed above, Hanna fails to teach or suggest all the limitations of the present claims; moreover, the Examiner concedes that Hanna does not teach the particular volatile linear and/or cyclic silicone oils of the presently rejected claims, nor the flash points of said volatile silicone oils. The Examiner relies on Elm to cure these additional admitted deficiencies. However, Elm does not and cannot cure the deficiencies of Hanna already set forth above, regardless of whether Elm teaches the elements asserted by the Examiner in such a way that one of skill in the art would be motivated to combine them, which Applicants do not admit Elm does. The gap between the combination of Hanna and Elm and the claimed invention is so great that one of ordinary skill in the art combining these references, without the benefit of hindsight, would not arrive at Applicants' claimed invention. The Aldrich Catalog does not teach or

suggest anything to rectify the deficiencies of Hanna and Elm either. Thus, the Examiner has not established a *prima facie* case of obviousness, and Applicants respectfully request that the Examiner withdraw this rejection.

C. Hanna in view of Bara et al. (U.S. Patent No. 6,224,851)

Claims 48-52 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanna as applied to claims 1, 17-42, 49-52, 70-95 and 99 above, and further in view of US Patent No. 6,224,851 B1 to Bara et al. ("Bara"). Office Action at p. 8. Applicants respectfully disagree and traverse the rejection for the reasons of record and for the additional reasons discussed below.

As discussed above, Hanna fails to teach or suggest all the limitations of the present claims; moreover, the Examiner concedes that Hanna does not teach the particular volatile fluorinated oils of the presently rejected claims. The Examiner relies on Bara to cure this additional admitted deficiency. However, Bara does not and cannot cure the deficiencies of Hanna already set forth above, regardless of whether Bara teaches the particular volatile fluorinated oils of the presently rejected claims in such a way that one of skill in the art would be motivated to combine them with the compositions of Hanna, which Applicants do not admit Bara does. The gap between the combination of Hanna and Bara and the claimed invention is so great that one of ordinary skill in the art combining these references, without the benefit of hindsight, would not arrive at Applicants' claimed invention. Thus, the Examiner has not established a *prima facie* case of obviousness, and Applicants respectfully request that the Examiner withdraw this rejection.

III. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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